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Image

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)	Art Unit:
)	
PEDERSEN, et al.)	Examiner:
)	
Serial No.: 10/507,121)	Washington, D.C.
)	
Filed: March 17, 2005)	July 11, 2005
)	
For: AN IMPROVED METHOD FOR)	Docket No.: PEDERSEN=9
SYNTHESISING TEMPLATED)	
MOLECULES)	Confirmation No.: 8893

INFORMATION DISCLOSURE STATEMENT [IDS] NO. 3

U.S. Patent and Trademark Office
Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

S i r :

This Information Disclosure Statement is submitted in accordance with 37 C.F.R. 1.97, 1.98, and it is requested that the information set forth in this statement and in the listed documents be considered during the pendency of the above-identified application, and any other application relying on the filing date of the above-identified application or cross-referencing it as a related application.

1. This IDS should be considered, in accordance with 37 C.F.R. 1.97, as it is filed:

☐ A. within three months of the filing date of the above-identified national application or within three months of the entry into the national stage of the above-identified international application. See 37 CFR 1.97(b)(1) and (3).

☒ B. before the mailing date of a first office action on the merits. See 37 CFR 1.97(b).

☐ C. after (A) and (B) above, but before final rejection or allowance, and Applicants have made the necessary certification (box "i" below) or paid the necessary fee (box "ii" below). See 37 CFR 1.97(c)(2).

☐ i. Counsel certifies that, upon information and

belief, each item of information listed herein was either (a) cited in a communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of this IDS or (b) was not cited in a communication from a foreign patent office in a counterpart foreign application and was not known to any individual designated in 1.56(c) more than three months prior to the filing of this IDS.

- [] ii. Credit Card Payment Form, PTO-2038, authorizing payment for the fee set forth in 1.17(p), presently believed to be \$180, is attached.

[] D. after (A), (B) and (C) above, but before payment of the issue fee. Applicant petitions under 37 C.F.R. 1.97(d) for consideration of this IDS. A Credit Card Payment Form, PTO-2038, authorizing payment for the fee set forth in 1.17(p)(1), presently believed to be \$180 is attached. Counsel certifies that, upon information and belief, each item of information listed herein was either (i) cited in a communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of this IDS or (ii) was not cited in a communication from a foreign patent office in a counterpart foreign application and was not known to any individual designated in 1.56(c) more than three months prior to the filing of this IDS.

[] E. As a submission in accordance with the transitional procedure for limited examination after final rejection pursuant to 37 CFR §1.129(a). Pursuant to MPEP §706.07(g), page 700-66, col. 2 (August 2001), this IDS is treated as if filed with a period set forth in 37 CFR §1.97(b) and considered without the petition and petition fee required by 1.97(d).

[] F. As a submission with or after a request for continued examination under CFR §1.114, and before the mailing of a first office action on the RCE. See 37 CFR §1.97(b)(4).

2. In accordance with 37 C.F.R. 1.98, this IDS includes a list (e.g., form PTO-1449) of all patents, publications, or other

information submitted for consideration by the office, either incorporated into this IDS or as an attachment hereto. A copy of each document is attached, except as explained below.

[] While an IDS filed under §1.97 must contain a "list of all patents, publications or other information submitted for consideration by the Office", see §1.98(a) (1), the only requirement for the list is that it provide the information set forth in §1.98(b). There is no requirement that a form PTO-1449 be used (MPEP §609 merely says that use of this form is "encouraged"). Counsel has used a list provided to him by Applicants, and not transferred the information to a PTO-1449, to avoid the risk of any inadvertent error in transferring the information.

[] A. Documents ____ are U.S. Patents or U.S. Patent Publications, and hence copies of these documents have not been provided. See 37 CFR 1.98(a) (2) (ii).

[X] B. Documents KU-LT were all previously cited by or submitted to the Office in the following prior application(s), which are relied upon under 35 U.S.C. 120:

10/175,539, filed June 30, 2002.

Applicants identify these documents by attaching hereto copies of the form PTO-892s and PTO-1449s from the files of the prior applications or a fresh PTO-1449 listing these documents, and request that they be considered and made of record in accordance with 1.98(d). Per 37 CFR 1.98(d), copies of these documents need not be filed in this application. If copies of any of these documents cannot be found in the files of the prior applications, the Examiner is requested to so notify counsel before taking action in this case, so replacement copies can be submitted. While an IDS filed under §1.97 must contain a "list of all patents, publications or other information submitted for consideration by the Office", see §1.98(a) (1), the only requirement for the list is that it provide the information set forth in §1.98(b). There is no requirement that a form PTO-1449 be used (MPEP §609 merely says that use of this form is "encouraged") and no prohibition on submitting a copy of a form

PTO-1449 or form PTO-892 from a prior case. Indeed, the re-use of such forms is desirable as it avoids error in transferring the information, and evidences that the reference was considered in a prior application. A previously accepted PTO-1449, or an examiner-prepared PTO-892, necessarily complies with §1.98(b).

[] 3. Document _____ is not in the English language. In accordance with 1.98(a)(3), Applicants state:

[] documents _____ already contain an English language abstract, summary or claim set.

[] a publicly available abstract is attached to document _____, and the source of the abstract is indicated thereon.

[] applicants have prepared an English translation of at least the pertinent portions of documents _____, and copies are attached.

[] A concise explanation of the relevance of documents _____ is found in the attached search report from the _____ Patent Office (see reply to Comment 68 in the preamble to the final rules; 1135 OG 13 at 20).

[] A concise explanation of the relevance of documents _____ appears in the present specification.

[] A concise explanation of the relevance of documents _____ is set forth as follows:

[Insert concise explanation of relevance]

4. No explanation of relevance is necessary for documents in the English language (see reply to Comments 67 and 68 in the preamble to the final rules; 1135 OG 13 at 20).

5. If the month of publication of a nonpatent reference is not stated, it is because it is not apparent from review of the reference. If requested to do so by the Examiner, Applicants will attempt to locate and write to the publisher.

If the publication date of a cited document is set forth only as a publication year, and that year is prior to the year of filing or, if priority is claimed, year of priority of this application, then the particular month of publication is not in issue. Likewise if that publication year is after the year of filing of this application, the month of publication is not in

issue.

If the date of publication of a nonpatent reference is stated, then, except as explained below, it is the nominal date stated in the reference, or in a larger document (journal or book) from which the reference was extracted. Applicants reserve the right to challenge this date by contacting the publisher to determine the actual shipment date, or by contacting recipients to determine the receipt dates.

6. Other information being provided for the examiner's consideration follows:

[insert other information]

7. In accordance with 37 C.F.R. 1.97(g) and (h), the filing of this IDS should not be construed as a representation that a search has been made or that information cited is, or is considered to be, material to patentability as defined in §1.56 (b), or that any cited document listed or attached is (or constitutes) prior art. Unless otherwise indicated, the date of publication indicated for an item is taken from the face of the item and Applicant reserves the right to prove that the date of publication is in fact different.

8. The Commissioner is hereby authorized and requested to charge any additional fees which may be required in connection with this paper or credit any overpayment to Deposit Account No. 02-4035.

Respectfully submitted,

BROWDY AND NEIMARK, P.L.L.C.
Attorneys for Applicant

By: 

Sheridan Neimark
Reg. No. 20,520

624 Ninth Street, N.W.
Washington, D.C. 20001
Telephone: (202)628-5197
Facsimile: (202)737-3528
SN:lms
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FORM PTO-1449
U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

ATTY DOCKET NO: Pedersen=9

SERIAL NO:
10/507,121

INFORMATION DISCLOSURE STATEMENT
LIST OF DOCUMENTS CITED BY APPLICANT
(Use several sheets if necessary)

APPLICANT: PEDERSEN, et al.

FILING DATE: March 17, 2005

GROUP:

U.S. PATENT DOCUMENTS (include at least patentee, patent number and issue date)

EXAMINER INITIAL		DOCUMENT NUMBER							DATE	PATENTEE		FILING DATE IF APPROP.
	KU	6	2	9	7	0	5	3	02OCT2001	Stemmer		
	KV	20	05	00	25	7	6	6	02FEB2005	Liu et al.		
	KW	20	05	00	42	6	6	9	24FEB2005	Liu et al.		

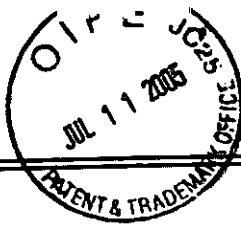
FOREIGN PATENT DOCUMENTS (include at least document number, publication date and country)

		DOCUMENT NUMBER							DATE	COUNTRY		TRANSLATION YES/NO
	KX	9	6	0	9	3	1	6	28MAR1996	PCT		
	KY	0	0	2	1	9	0	9	20APR2000	PCT		
	KZ	02	1	0	2	8	2	0	27Dec2002	PCT		
	LA	03	0	7	8	6	2	5	25Sept2003	PCT		
	LB	20	04	01	3	0	7	0	12Feb2004	PCT		
	LC	20	04	11	0	9	6	4	23DEC2004	PCT		
	LD	20	04	02	4	9	2	9	25Mar2004	PCT		
	LE	20	04	05	6	9	9	4	08July2004	PCT		
	LF	03	0	7	8	4	4	5	25Sept2003	PCT		
	LG	03	0	7	8	6	2	6	25Sept2003	PCT		
	LH	03	0	7	8	0	5	0	25Sept2003	PCT		
	LI	03	0	7	8	6	2	6	25Sept2003	PCT		
	LJ	20	04	07	4	5	0	1	2Sept2004	PCT		
	LK	20	04	07	4	4	2	9	2Sept2004	PCT		
	LL	20	04	08	3	4	2	7	30Sept2004	PCT		
	LM	20	04	03	9	8	2	5	13May2004	PCT		
	LN	20	04	00	1	0	4	2	31Dec2003	PCT		
	LO	20	04	0	0	9	8	14	29JAN2004	PCT		
	LP	1	5	3	3	3	8	5	25May2005	EP		
	LQ	0	3	0	7	8	4	46	25Sept2003	PCT		

EXAMINER

DATE CONSIDERED

EXAMINER: Initial if reference considered. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.



FORM PTO-1449
U.S. DEPARTMENT OF COMMERCE
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(Use several sheets if necessary)

APPLICANT: PEDERSEN, et al.

FILING DATE: March 17, 2005

GROUP:

OTHER DOCUMENTS (include author, title, name of publication, volume, pages and date of publication)

LR

Doyon, J.B et al. "Highly sensitive in vitro selections for DNA-linked synthetic small molecules with protein binding affinity and specificity" J. AM. CHEM. SOC., September 16, 2003, pp. 1-2 and S1-S8.

LS

Kanan, M.W et al. "Reaction discovery enabled by DNA-templated synthesis and in vitro selection" Nature, Vol. 431, 30 September 2004, pp. 545-549.

LT

"Finding reactions in a haystack: Try'em all, see what works" Meeting American Chemical Society, 10 September 2004, Vol. 305, Science.

EXAMINER

DATE CONSIDERED

EXAMINER: Initial if reference considered. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.